

## REMARKS

Claims 1-24 are pending in the Application.

The Examiner rejected claims 1-7 under 35 U.S.C. § 103 as being unpatentable over various combinations of documents.

Applicant has amended claims 2 and 3, and added claim 24.

Support for the amendment to claim 2 and 3, and for new claim 24, may be found, for example, at Fig. 18 and paragraphs 109 and 110. Of course, the claims are not limited to the disclosure at Fig. 18 and paragraphs 109 and 110.

The Examiner rejected claim 1 under 35 U.S.C. § 103 as being unpatentable over Jovicic et al. [US 5,855,007] in view of Nemirofsky [US 5,953,047], and Valencia et al. [US 5,380,991]. (Office Action page 5).

Applicant submits that claim 1 is nonobvious in view of the art of record, and otherwise complies with the statutes and regulations.

Jovicic et al. discloses an “electronic coupon communication system for generating and redeeming unique product discount coupons over public computer networks such as the Internet. . . .The Internet coupon server accepts an on-line selection of one of the available unique Internet coupons from a user of the Internet node and transmits the coupon back to the user's printing device or e-mail storage. It then records the transaction in its coupon database and notifies the transaction to the Internet Coupon Notification Center. The Internet Coupon Notification Center subsequently records the transaction.” Jovicic et al. Abstract.

“According to the [Jovicic et al.] invention, user's general computing device connected to the public network such as the Internet 122, establishes an on-line session with the Internet Coupon Server 124, preferably goes through the registration process 408 if the user is a new user, and then, after the coupon generation process 410 described in detail below, makes a selection 412 from the available coupons in the Internet Coupon Server's browsing memory 128 . . .” Jovicic et al. col. 7, lines 56-64.

“Once the user viewing the display 116 selects an electronic coupon 300 being displayed, such as by entering user input at the keyboard 114, the Internet Coupon Server 124 may ask the user to choose if the coupon is to be mailed electronically, Internet

Coupon Server 124 prompts the user to input an electronic mail address 418. When electronic mail address is inputted, Internet Coupon Server 124 mails the coupon electronically to the addressee 420.” Jovicic et al. col. 8, lines 10-17.

“An added feature of the invention is that the user may choose to e-mail the coupon to him or herself allowing him or her to store the coupon for a later date handling or to send it directly to the vendor's Internet node over public computer network. . . . If the user elects not to mail the coupon electronically, Internet Coupon Server 124 prompts the user to input 424 whether the coupon is to be printed on the user's printing device 118. If the user chooses the printing option, the Internet Coupon Server 124 sequentially transmits coupon's digital data pattern to the Internet node's CPU 104 and the Internet node's printing device 118.” Jovicic et al. col. 8, lines 18-40.

The Examiner concedes that Jovicic et al. does not disclose writing the coupon data onto a smart card, but reasoned that “Nemirofsky discloses transmitting coupon data to a computer screen over a computer network and writing the coupon data onto a smart card [col 8, lines 20-24]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Jovicic et al. to include the method disclosed by Nemirofsky. Nemirofsky provides the motivation that the invention achieves real-time interactivity and is convenient for consumers.” (Office Action, page 6) (emphasis added).

The Examiner stated “Valencia discloses a paperless coupon redemption system and method that includes a smart card . . . Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Jovicic et al. to include the method disclosed by Valencia et al. Valencia provides the motivation that the method allows a shopper to obtain the benefit of reduced prices for certain items without the necessity of redeeming paper coupons.” (Office Action, page 6) (emphasis added).

In contrast, claim 1 recites, inter alia, a method of downloading a coupon for a product. The method comprises transmitting to the user computer by using an address associated with the user computer, via the global computer network, data referring to the product; subsequently receiving from the user computer, via the global computer network, data indicating that the user desires to receive a coupon for the product;

responsive to the receiving step, transmitting to the user computer, via the global computer network, coupon data representative of the coupon, and writing the coupon data into the electronic memory of the smart card. No reasonable combination of the art of record would have suggested claim 1's peculiar combination including the recited steps of transmitting, receiving, and transmitting between the user computer and the global computer network, yet writing the coupon data into the electronic memory of a smart card.

The Examiner stated it would have been obvious "to modify the invention of Jovicic et al. to include the method disclosed by Nemirofsky. Nemirofsky provides the motivation that the invention achieves real-time interactivity and is convenient for consumers." (Office Action, page 6) (emphasis added). This statement by the Examiner is inapplicable to claim 1. The addition of Nemirofsky's card writing to Jovicic et al. would not increase the interactivity of Jovicic et al. Furthermore, such a modification of Jovicic et al. would be less advantageous for consumers. In Jovicic et al., without the Examiner's attempted modification, the consumer seeking to redeem a coupon may 1) use electronic means, thereby having the advantage of no materials carried by the consumer; or 2) print the coupon, thereby having the advantage of the coupon information visible on a substrate carried by the consumer. Modifying Jovicic et al. to require the carrying of a smart card would be a less advantageous for consumers.

In other words, given that the user of the Jovicic et al. system may 1) direct an electronic coupon via a network, or 2) have the coupon information visible on a substrate, there would have been no motivation to write the coupon into an electronic memory that the user would then be required to carry. In fact, because of this relative disadvantage, one would have been disinclined to modify Jovicic et al. to provide for writing their network coupon into Applicant's recited electronic memory of a smart card.<sup>1</sup>

The Examiner's reliance on Valencia, as the purported motivation to modify Jovicic et al., is also inapplicable to claim 1. The Examiner stated, "Valencia provides the

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1. An additional disadvantage, of the Examiner's attempted combination, is that it would require a smart card writer.

motivation that the method allows a shopper to obtain the benefit of reduced prices for certain items without the necessity of redeeming paper coupons.” (Office Action page 6). Applicant notes, however, that there is already no necessity of redeeming paper coupons in Jovicic et al.’s system, unless the user chooses to do so. Thus, this motivation proffered by the Examiner is nonexistent.

In summary, "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art". *In re Wesslau*, 353 F.2d at 241, 147 U.S.P.Q. at 393. Thus, one cannot take Jovicic et al.’s network-based selection of electronic coupons while discarding both Jovicic et al.’s network-based redemption and paper-based redemption.

The Examiner rejected claims 2-4 under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al. in view of Nemirofsky, Valencia et al., and Christensen et al. [U.S. Patent 5,710,886].

Jovicic et al., Nemirofsky, and Valencia et al. are described above.

Applicant notes that Christensen et al. disclose “a SELLECTSOFT™ diskette may be created containing coupon information and program data for displaying and generating coupons.” Christensen et al. col. 5, lines 31-34. “[T]elemarketing personnel may request consumer demographic and or identification information which may be entered into a centralized database. Once the software is validated, a consumer may print out selected coupons displayed on a Graphical User Interface (GUI).” Christensen et al. Abstract.

The Examiner cites Christensen et al. col. 8, line 42 - col. 9, line 8, which states: “From instruction screen 5, the user may proceed to main menu screen 6. FIGS. 12-13 illustrate the further operation of the menu system. A consumer may click on a general category, and then click on more specific categories within that general category . . . . When a validation number has been previously entered, a user may proceed directly to instruction screen 5 or main menu screen 6 once the SELLECTSOFT™ software has been loaded.” . . . A user may browse through screens of coupons within a category, or through various screens in various categories, as illustrated in FIGS. 12 and 13. In addition, a

simple text search engine may be provided to enable the consumer to quickly find coupons of interest. A consumer may enter a word or portion of a word defining a brand name, category, or generic product name. The SELLECTSOFT™ software may then display a coupon or coupons.”

Thus, Christensen et al. cannot make up for the deficiencies in the other references already cited, and claim 2, as amended, is patentable as it recites, *inter alia*, a method of downloading a coupon for a product. The method comprises, *inter alia*, transmitting to the user computer by using an address associated with the user computer, via the global computer network, data referring to the product; subsequently receiving from the user computer, via the global computer network, data indicating that the user desires to receive a coupon for the product; writing the coupon data into the electronic memory of the smart card using the first smart card reader/writer; reading the coupon data with the second smart card reader/writer of a checkout station having circuitry configured to communicate over a computer network. No reasonable combination of the art of record suggests claim 2’s peculiar interrelation of steps including writing coupon data to a smart card, pursuant to transmitting and receiving from a computer network, and reading the coupon data from the smart card at a checkout station, having circuitry configured to communicate over a computer network having a plurality of nodes one of the nodes being coupled to a telecommunications link. In the presence of the recited computer networks available both at the place of writing and the place of reading the coupon data, there would have been no motivation to impose this relative inconvenience of using a first smart card reader/writer and a second smart card reader/writer. There would have been no obvious advantage of using a smart card reader/writer in this context where networks render a smart card reader/writer unnecessary.

Claim 3, as amended, is patentable as it recites a method of downloading a coupon for a product. The method comprises, *inter alia*, transmitting to the user computer by using an address associated with the user computer, via the global computer network, data referring to the product; subsequently receiving from the user computer, via the global computer network, data indicating that the user desires to receive a coupon for the product; writing the coupon data into the electronic memory of the smart card using the first smart

card reader/writer.

Claim 4 is patentable as it recites *inter alia*, transmitting to the user computer by using an address associated with the user computer, via the global computer network, data corresponding to a coupon for a product; subsequently receiving from the user computer, via the global computer network, data indicating that the user desires to receive the coupon; transmitting to the user computer by using the address, via the global computer network, data representative of the coupon that is capable of being written into the electronic memory of the smart card by the user smart card reader/writer.

The Examiner rejected claim 5 under 35 U.S.C. 103(a) as being unpatentable over Jovicic et al. in view of Jones [US 5,500,681], and Valencia et al.

Jovicic et al. and Valencia et al. are described above.

Jones discloses that "Coupon information is stored in a memory at a cable television station . . . The video signal may at times, such as during a product advertisement or other offer, include an embedded coupon identifier. A coupon subsystem at the cable television station monitors each video signal and retrieves token information from a database when it detects a corresponding embedded token identifier. The coupon information is transmitted over a data channel on the cable network. A subscriber unit at the television viewer's site receives the data channel and extracts the coupon information. The television programming aurally or visually alerts the viewer that a coupon may be generated. If the viewer actuates an input device, such as a button on a television remote control, a printer generates a coupon bearing the coupon information." Jones Abstract.

The Examiner stated, "Jones et al discloses transmitting selected coupon to a user through the use of a packet [col 4, lines 9-27 and 39-49]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Jovicic et al. to include the method disclosed by Jones et al. to transmit longer messages more efficiently and reliably." (Office Action page 10).

Thus, Jones cannot make up for the deficiencies in the other references already cited, and claim 5 is patentable as it recites, *inter alia*, a method of receiving and redeeming coupons, redeemable at a store, with a smart card with a computer. The method comprises viewing a plurality of available downloadable coupons, received in a

packet having an address associated with the user computer in the global computer network, on the computer monitor; subsequently generating an input to the computer indicating a selection of a selected coupon from the plurality of available downloadable coupons, to cause the computer to send data, corresponding to the selected coupon, into the global computer network; subsequently receiving data corresponding to the selected coupon, the received data having been transmitted using the address through the global computer network after step (b), and causing the received data to be written to an electronic memory of the smart card.

The Examiner rejected claim 6 under 35 U.S.C. 103(a) as being unpatentable over Valencia et al. in view of Jovicic et al. and Nemirofsky et al.

Valencia et al., Jovicic et al., and Nemirofsky are described above.

In contrast, claim 6 is patentable as it recites an electronic coupon downloading apparatus, comprising a processor in bi-directional communication with a global computer network; and program instructions that receive a user selection, send the received selection through the global computer network, receive coupon data corresponding to the selection, the received coupon data having been transmitted through the global computer network after the program instructions send program sends the corresponding selection through the global computer network; and cause the processor to write coupon data that is received via the global computer network into an electronic memory of a smart card. No reasonable combination of the art of record suggests this peculiar combination including program instructions to cause the recited writing of coupon data after the recited bi-directional communication.

The Examiner rejected claim 7 under 35 U.S.C. 103(a) as being unpatentable over Christensen et al. in view of Jovicic et al., Nemirofsky, and Valencia et al.

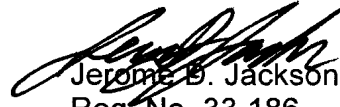
Christensen et al. in view of Jovicic et al., Nemirofsky, and Valencia et al. are described above.

In contrast, claim 7 is patentable as it recites a processor in bi-directional communication with a global computer network; user program instructions a program that receive receives a user selection, sends the received selection through the global computer network, receive receives coupon data corresponding to the selection, the

received coupon data having been transmitted through the global computer network after the program instructions send program sends the corresponding selection through the global computer network; and cause causes the processor to write coupon data that is received via the global computer network into an electronic memory of a smart card via the first smart card reader/writer. No reasonable combination of the art of record suggests this combination including program instructions to cause the recited writing of coupon data after the recited bi-directional communication.

If the Examiner has any questions about this amendment, applicant's representative would appreciate discussing this amendment with the Examiner. Applicant's representative, Jerome Jackson, can be reached at 703-684-4840.

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